

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ANIL V. RAO and WAYNE R. WEILNAU

Appeal 2007-0350
Application 09/271,581
Technology Center 2100

Decided: April 25, 2007

Before JOSEPH L. DIXON, ANITA PELLMAN GROSS, and
STUART S. LEVY, *Administrative Patent Judges*.

DIXON, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the Examiner's Final Rejection of claims 1-28.

We AFFIRM.

BACKGROUND

Appellants' invention relates to a system and method for installing system manufacturer provided software. An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below.

1. A method of selectively installing after sale software provided by a computer system manufacturer after sale of a computer system onto a computer system manufactured by the computer system manufacturer, said method comprising:

reading a configuration file that contains computer system information, the computer system information including manufacturer specific identification information identifying the computer system manufacturer;

determining an encrypted key from one or more bytes from the configuration file including the manufacturer specific identification information;

deciphering data stored on a nonvolatile storage device using the key so as to ensure that the after sale software provided by the computer system manufacturer after the sale of the computer system is installed only on a computer system manufactured by the computer system manufacturer.

PRIOR ART

The prior art references of record relied upon by the Examiner in rejecting the appealed claims are:

Kubota	US 5,034,980	Jul. 23, 1991
Pearce	US 5,694,582	Dec. 2, 1997
Dollahite	US 5,748,877	May 5, 1998
Cooper	US 5,757,907	May 26, 1998
Saxena	US 6,259,449 B1	Jul. 10, 2001
Chrabaszcz	US 6,363,497 B1	Mar. 26, 2002

Patterson US 6,389,541 B1 May 14, 2002

REJECTIONS

Claims 1, 4, 5, 8, 10, 12, 13, 16, 18, 20, and 22-28 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Kubota in view of Patterson. This rejection is based in the original new grounds of rejection made by the Board in Appeal 2005-1228, dated Aug. 30, 2005.

Claims 2 and 11 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Kubota in view of Patterson, as applied to claims 1 and 10, and in view of Chrabaszcz.

Claim 3 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Kubota in view of Patterson in view of Chrabaszcz, as applied to claim 2, and further in view of Dollahite.

Claims 6 and 14 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Kubota in view of Patterson, as applied to claims 1 and 10, and further in view of Cooper.

Claims 7 and 15 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Kubota in view of Patterson, as applied to claims 1 and 10, and further in view of Pearce.

Claims 9 and 17 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Kubota in view of Patterson, as applied to claims 1 and 10, and further in view of Saxena.

Claims 19 and 21 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Kubota in view of Patterson as applied to claims 18 and 20 above, and further in view of Chrabaszcz.

Rather than reiterate the conflicting viewpoints advanced by the Examiner and the Appellants regarding the above-noted rejection, we make reference to the Examiner's Answer (mailed Jun. 9, 2006) for the reasoning in support of the rejections, and to Appellants' Brief (filed Apr. 10, 2006) for the arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to Appellants' Specification and claims, to the applied prior art references, and to the respective positions articulated by Appellants and the Examiner. As a consequence of our review, we make the determinations that follow.

We note the basic rejection was made by the Board, and the Examiner has relied heavily upon that rejection in setting forth the present rejection on appeal. We note that the claims were amended, but the original claims from the prior appeal were attached in the Appendix to the Brief.

We select independent claim 1 and will address Appellants' arguments thereto. Additionally, we note that the additional references were not argued and that appellants have relied upon the arguments for the primary combination used for the independent claims. Therefore, we will treat those dependent claims as grouped with their respective independent claims. The failure of Appellants to separately argue claims which appellant has grouped together constitutes a waiver of any argument that the Board must consider the patentability of any grouped claim separately. *See In re McDaniel*, 293 F.3d 1379, 1384, 63 USPQ2d 1462, 1465-66 (Fed. Cir. 2002).

At the outset, we note that to reach a proper conclusion under § 103, the Examiner, as finder of fact, must step backward in time and into the mind of a person of ordinary skill in the art at a time when the invention was unknown, and just before it was made. In light of all the evidence, we review the specific factual determinations of the Examiner to ascertain whether the Examiner has convincingly established that the claimed invention as a whole would have been obvious at the time of the invention to a person of ordinary skill in the art. When claim elements are found in more than one prior art reference, the fact finder must determine “whether a person of ordinary skill in the art, possessed with the understandings and knowledge reflected in the prior art, and motivated by the general problem facing the inventor, would have been led to make the combination recited in the claims.” *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1337 (Fed. Cir. 2006). With respect to the role of the Examiner as finder of fact, the Court of Appeals for the Federal Circuit has stated: “the examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability.” *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). The Court of Appeals for the Federal Circuit has also noted: “[w]hat the prior art teaches, whether it teaches away from the claimed invention, and whether it motivates a combination of teachings from different references are questions of fact.” *In re Fulton*, 391 F.3d 1195, 1199-1200, 73 USPQ2d 1141, 1144 (Fed. Cir. 2004) (internal citations omitted).

First, we look to interpret independent claim 1. We note that independent claim 1 sets forth a preamble that states “A method of

selectively installing after sale software provided by a computer system manufacturer after sale of a computer system onto a computer system manufactured by the computer system manufacturer.” We note that the preamble set forth and promises the installing of software, but we find no step of installing or accomplishing of this function. The last step recites: “deciphering data stored on a nonvolatile storage device using the key so as to ensure that the after sale software provided by the computer system manufacturer after the sale of the computer system is installed only on a computer system manufactured by the computer system manufacturer.” We find that the limitation “deciphering . . . to ensure . . . is installed only on a computer system manufactured by the computer system manufacturer” does not positively set forth that software is installed. Here, Appellants tend to infer a relationship between the “selective installing” and the “to ensure” function. We cannot agree with this inferred relationship.

Appellants argue that the Examiner’s argument:

does not appreciate that or take into consideration that the claim limitations that set forth that the after sale software is provided *by the computer system manufacturer* and that the after sale software is installed *only* on a computer system manufactured by the computer system manufacturer as substantially required by each independent claim. Applicants maintain that this feature is neither directly nor inherently disclosed by the cited references.

Kubota discloses a microprocessor which provides copy protection. The microprocessor includes an integrated decoding circuit having a unique cryptographic code for providing copy protection of protected computer software (Kubota, Col. 2, lines 62 - 65.) When a microprocessor is manufactured, a key associated with an ID of the microprocessor is embedded into the decoder. (Kubota, Col 3, line 67 - Col. 4, line 1.) When copy protection of software is desired, the

software is encrypted to function uniquely with the microprocessor. (Kubota, Abst.) (Br. 6).

Appellants argue that:

Kubota discloses and relates solely to microprocessors. Kubota does not provide any disclosure relating to computer systems, much less to identifying a particular computer system manufacturer. Applicants respectfully submit that providing manufacturer specific identification information identifying a computer system manufacturer is patentably distinct from uniquely identifying a particular microprocessor as disclosed in Kubota. Accordingly, Kubota does not teach or suggest all of the claim limitations of the claimed invention. (See M.P.E.P. 2143.03.) (Br. 6-7).

We disagree with Appellants and do not find any persuasive argument or basis for why providing manufacturer specific identification information identifying a computer system manufacturer is patentably distinct from uniquely identifying a particular microprocessor as disclosed in Kubota. We find that this information is non-functional as to what function it performs. We find that the use of stored identification data to limit a system is taught and fairly suggested by Kubota.

Additionally, we find that the teachings of Kubota are clearly suggestive of other uses in the computer related technologies since Kubota teaches the use with respect to the microprocessor which is the heart of the computer systems. We find that Kubota recognizes and suggests that there is a desire and need to limit what may interact with the microprocessor. We find that one such limiting element that would have been readily apparent to skilled artisans would have been software.

Appellants argue that:

Kubota and Patterson do not provide any disclosure relating to computer systems, much less to identifying a particular computer system manufacturer such that after sale software provided *by the computer system manufacturer* and after sale software is installed *only* on a computer system manufactured by the computer system manufacturer as substantially required by each independent claim. Applicants respectfully submit that providing manufacturer specific identification information identifying a computer system manufacturer to enable these features is patentably distinct from uniquely identifying a particular microprocessor as disclosed in Kubota. The deficiencies of Kubota are not completed by Patterson. As with Kubota, Patterson provides no disclosure relating to providing manufacturer specific information identifying a computer system manufacturer to [sic] as to ensure that after sale software is installed only on a computer system manufactured by the computer system manufacturer, as substantially required by claims 1, 10, 18, 20 and 22. Accordingly, claims 1, 10, 18, 20 and 22 are allowable over Kubota and Patterson. (Br. 7).

Again, we find that Appellants contend that there is a patentable distinction in the recitation of computer systems and identifying a particular computer system manufacturer rather than identifying a microprocessor or part of a computer system. We find this argument unsupported by any specific argument or analysis to persuade us of an error in our original formulation of the basic rejection. Therefore, Appellants' argument is not persuasive.

With respect to the temporal aspect of the invention, we do not find this argument to "after sale software" to be persuasive of a patentable distinction since the computer may be resold to redefine the relative time of sale or the computer may be a custom manufactured system and deemed to be sold prior to manufacture so that all software would be "after sale

software.” Therefore, we do not find argument to this limitation to be persuasive.

Appellants argue that:

More specifically, neither Kubota or Patterson disclose or suggest a method of selectively installing software onto a computer system manufactured by a computer system manufacturer where the method includes reading a configuration file that contains computer system information including manufacturer specific identification information *identifying the computer system manufacturer* and deciphering data stored on a nonvolatile storage device using the key *so as to ensure that the software is installed only on a computer system manufactured by the computer system manufacturer*, as required by independent claim 1. (Br. 7).

We agree with Appellants that neither of the individual references teaches or suggests the invention as recited in the language of independent claim 1, but it is the combined teachings in light of what would have been readily apparent to those skilled in the art at the time of the invention with which the Examiner rejected the claims. We do not find Appellants’ arguments persuasive and do not find them sufficient to show a deficiency in the Examiner’s *prima facie* case of obviousness, and we will sustain the rejection of independent claim 1 and dependent claims 2-9 and 24 which Appellants have elected to group therewith (Br. 8).

With respect to independent claim 10, Appellants advance the same contention as with respect to independent claim 1 (Br. 8). Appellants merely reiterate the claim limitations and maintain that neither Kubota nor Patterson teaches or suggests the claim limitations. Since we did not find this argument persuasive with respect to independent claim 1, we do not find the

same argument to similar limitations persuasive here. Therefore, we sustain the rejection of independent claim 10 and its dependent claims 11-17 and 25.

With respect to independent claims 18, 20, and 22, Appellants advance the same contention as with respect to independent claim 1 (Br. 8). Appellants merely reiterate the claim limitations and maintain that neither Kubota nor Patterson teaches or suggests the claim limitations. Since we did not find this argument persuasive with respect to independent claim 1, we do not find the same argument to similar limitations persuasive here. Therefore, we sustain the rejection of independent claim 18, 20, and 22 and dependent claims 19, 26, 21, 27, and 28.

With respect to independent claim 23, Appellants advance the same contention as with respect to independent claim 1 (Br. 8). Appellants merely reiterate the claim limitations and maintain that neither Kubota nor Patterson teaches or suggests the claim limitations. Since we did not find this argument persuasive with respect to independent claim 1, we do not find the same argument to similar limitations persuasive here. Therefore, we sustain the rejection of independent claim 23.

CONCLUSION

To summarize, we have sustained the rejections of claims 1-28 under 35 U.S.C. § 103(a).

Appeal 2007-0350
Application 09/271,581

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

tdl/ce

HAMILTON & TERRILE, LLP
P.O. BOX 203518
AUSTIN TX 78720